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Paper No. 36

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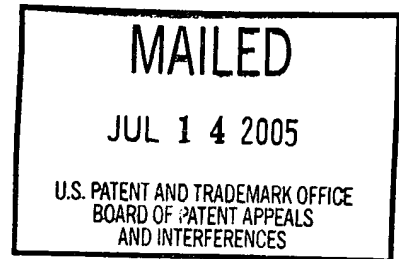
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Ex parte GADI KARMI
and MATT GROB

Appeal No. 2004-1655
Application 09/158,938¹

ON BRIEF



Before HAIRSTON, BARRETT, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-124.

We affirm-in-part.

¹ Application for patent filed September 22, 1998, entitled "Overhead Message Update With Decentralized Control."

BACKGROUND

The background of the invention describes that it was known to include a "sequence number" along with an "overhead message" in a paging channel of a cellular system. The mobile unit periodically wakes up and listens to the paging channel. When the mobile wakes up, it receives the sequence number of the overhead message and decides whether to stay awake and receive the overhead message. In many instances, the mobile unit will go back to sleep after receiving the sequence number because the sequence number is the same as the sequence number received the last time the mobile unit woke up. Limiting the time the mobile unit performs the listening function reduces the overall power consumption and increases the battery life. See specification, pages 3-4. This prior art method is said to be not directly applicable to decentralized systems, such as systems supporting packet data service, where there is typically no central controller for updating overhead messages. The invention uses a "signature" that uniquely identifies the overhead message, which allows a mobile unit to identify new messages to decode while ignoring those that have already been received and decoded. Thus, the invention is replacing a "sequence number" with a "signature."

Claim 1 is reproduced below.

1. A method for communicating messages to a mobile station by a wireless communication system providing access to a decentralized data network, the method comprising the steps of:

providing a sequence of messages;

providing for each respective message a respective signature, the respective signature being separate from the respective message; and

comparing the respective signature for any given respective message with at least one signature.

THE REFERENCES

The examiner relies on the following references:

Tiedemann, Jr. et al.	5,392,287	February 21, 1995
(Tiedemann)		
Schwendeman	5,396,537	March 7, 1995

THE REJECTIONS

We refer to the final rejection (Paper No. 24) (pages referred to as "FR__") and the examiner's answer (Paper No. 33) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 32) (pages referred to as "Br__") for a statement of appellants' arguments thereagainst.

Claims 1-124 stand rejected under 35 U.S.C. § 112, first paragraph. For the reasons discussed in the opinion, we interpret the rejection to be based on lack of enablement for one skilled in the art to make and use a "signature."

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Claims 1-43, 48-58, 62, 63, 65-81, and 86-94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tiedemann and Schwendeman.²

OPINION

Note to examiner and appellants

When the amendment to page 13 of specification at pages 2-3 of Paper No. 17, filed May 21, 2001, was entered, the paragraph at page 13, lines 5-19, was inadvertently crossed off in addition to the paragraph at page 13, line 20, to page 14, line 13, possibly because the paragraphs start out similarly. The examiner should make sure that this error is corrected and appellants may wish to ensure that this is done before issue.

Section 112, first paragraph

Initially, we clarify the ground of rejection as based on lack of enablement. The statement of the rejection says that the subject matter is not described in such as way as to reasonably convey that appellants "had possession of the claimed invention" (FR2). "Lack of possession" indicates a lack of written description support, which is used to reject when a claim is amended or a new claim added to recite elements thought to be

² The discussion of the rejection includes claims 118-120 and indicates that Official Notice is used in connection with claims 50-52, 88-90, and 118-120. Since the examiner has not rejected independent claim 95, we assume that the mention of claims 118-120 is a mistake.

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without support in the original disclosure. See In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). The disclosure "must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention." Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). However, the examiner is concerned with the term "signature" not being clearly disclosed. Since a "signature" is expressly disclosed and claimed in the application as filed, there can no question of written description support.

In the discussion, the examiner states that "the concept of signature has not been clearly defined in the present application in such a way as to reasonably convey to one skilled in the relevant art how to make and use the present invention" (FR2). This reasoning goes to enablement and is consistent with the discussion that the specification does not "disclose what a signature is, and how such signature is different from a sequence number" (FR2). Appellants have responded to discussion of signatures (Br6) and, thus, we find no harm to appellant in labeling the rejection as based on lack of enablement.

Signatures are discussed at pages 7 and 12-16. The specification describes that "[a] signature can be generated by hashing the message using a well-known hashing function to produce a sixteen or thirty-two bit signature" (page 14,

lines 18-20) and "[t]he length of the signature in bits depends on system requirements that two consecutive messages share different signatures (i.e., avoid collisions)" (page 14, lines 24-26). Thus, one of ordinary skill in the art is expressly taught at least one well-known way to generate a signature (hashing the message) and that signatures from two consecutive messages must be unique. The enablement rejection of claims 1-124 is reversed.

The examiner's concerns about how a signature is different from a sequence number appear to really concern claim breadth. Claim breadth should not be confused with indefiniteness. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). Nor should claim breadth be confused with lack of enablement. The claims recite a signature, but do not define the signature or state how it is generated. A "signature" is broad enough to read on a "sequence number" because a sequence number also uniquely identifies a message and because no method of generating a signature has been claimed.

Section 103(a)

The claims are argued to stand or fall together (Br4). Claim 1 is taken as representative.

The examiner interprets "the term signature to be equivalent to sequence number since the present application also lacks of a

proper disclosure providing a **clear** differentiation between signature and sequence number" (FR3). The examiner finds that Tiedemann discloses a mobile station which receives a sequence of messages, each message containing a sequence number (signature) generated by a transmitter in a base station, wherein the receiver compares the sequence number (signature) of a message with at least one sequence number (signature), referring to column 8, lines 54-64 (FR4-5). The examiner finds that Tiedemann does not disclose that the sequence number (signature) is separate from the message (FR5). The examiner finds that Schwendeman discloses a message capsule 204 that includes a sequence number 208 (signature) that is not included in the message 200 for the purposes of reducing transmission overhead in a paging communication system, referring to Figs. 1 and 2 and column 16, lines 38-43 (FR5). The examiner concludes that it would have been obvious to modify Tiedemann to provide sequence numbers separately from the overhead messages as taught by Schwendeman, thereby allowing comparison of the sequence numbers without decoding the whole message and saving power (FR5).

Appellants argue that the examiner incorrectly examined the pending claims believing the term signature to be equivalent to sequence number (Br9): "While each signature is an identifier of a corresponding overhead message, the signature is NOT equivalent to a sequence number. Appellants note that the embodiment

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detailed on page 14, ll. 18-30, describes the use of hashing function to generate a signature. The hashing function result IS NOT a sequence number."

We do not find where the examiner specifically responds to this argument. However, in connection with the enablement rejection, the examiner states that the fact that page 14 describes how a signature can be generated "does not explain how a signature is different from a sequence number" (EA12). Thus, the examiner's position is that the claimed "signature" does not distinguish over a "sequence number." We agree. Claim 1 does not define a signature or how it is generated. The fact that the specification discloses using a hashing function to generate a signature cannot be read into the claim. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (before the application is granted, when the claims can be amended, there is no reason to read into the claim the limitations of the specification). A "signature" is a unique identifier and is therefore broad enough to read on a "sequence number" because a sequence number also uniquely identifies a message. Both the sequence number and the signature change when the message changes and, so, the limitation of "providing for each respective message a respective signature" is met. It is true that the hashing function result is not a sequence number, but claim 1 does not

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recite generating a signature by hashing. Appellants do not state why a sequence number cannot be considered a signature.

Appellants argue that the messages in Tiedemann and Schwendeman have the same structure with the sequence number included in the message and, therefore, there is no motivation to combine the references (Br9).

The examiner responds that appellants focus on an embodiment of Schwendeman not relied upon by the examiner. It is noted that Schwendeman clearly disclose a sequence number 208 (signature) that is not included in the message.

We agree with the examiner that Schwendeman expressly teaches that the sequence number can be separate from the overhead message and appellants have not provided any reasons why it would not have been obvious to modify Tiedemann in the manner proposed by the examiner. Thus, appellants have not shown error in the examiner's rejection. It is noted that appellants' Description of the Related Art (specification, pages 1-6) discusses providing sequence numbers separately from the overhead message so that the mobile unit only has to check the sequence number before deciding whether to stay awake and receive the overhead message (pages 3-4). Although the section is entitled "Description of Related Art" instead of "Description of Prior Art," it appears that appellants are describing prior art at

least absent some statement that it is not prior art, and that claim 1 is so broad that it reads on this prior art.

Arguments not made are considered to be abandoned and have not been addressed. See 37 CFR § 1.192(c)(8)(iv) (2002) (brief must point out errors in the rejection). Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Watts, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("Just as it is important that the PTO in general be barred from raising new arguments on appeal to justify or support a decision of the Board, it is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board." (Footnote omitted.)). It is not clear if and how the preamble limitations to a "wireless communication system providing access to a decentralized data network" interact with and limit the steps in the body of the claim, but since this is not argued, we decline to raise the issue.

For the reasons stated above, we conclude that appellants have failed to show error in the examiner rejection. The obviousness rejection of claims 1-43, 48-58, 62, 63, 65-81, and 86-94 is sustained.

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CONCLUSION

The rejection of claims 1-124 under 35 U.S.C. § 112, first paragraph, lack of enablement, is reversed.

The rejection of claims 1-43, 48-58, 62, 63, 65-81, and 86-94 under § 103(a) is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART


KENNETH W. HAIRSTON
Administrative Patent Judge


LEE E. BARRETT
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714